

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-22 and 24-27 are currently pending in the application. No claims have been amended, added, or cancelled. Therefore, claims 1-22 and 24-27 are present for examination. Claims 1, 14, and 22 are independent claims.

Prior to entry of this amendment, the application included claims 1-22 and 24-27. An Office Action mailed August 19, 2008 has rejected claims 1-22 and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0152160 A1 to Allen-Rouman et al. ("**Allen-Rouman**") in view of U.S. Patent No. 6,058,417 to Hess et al. ("**Hess**"), and further in view of www.Tomsown.com/htmlsnippet.html ("**Tomsown**").

Claim Rejections Under 35 U.S.C. 103

Claims 1-22 and 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen-Rouman in view of Hess, and further in view of Tomsown. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. See, e.g., *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). The Examiner must then provide an explicit analysis supporting the rejection. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. See MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

Examiner relies on Allen-Rouman to show one or more of the limitations of the claims. However, reliance on Allen-Rouman for this obviousness rejection is improper.

Allen-Rouman is prior art only under 35 U.S.C. § 102(e), which states:

A person shall be entitled to a patent unless — . . .

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. . . .

Allen-Rouman is not prior art under any of the other sections of 35 U.S.C. § 102.

Per 35 U.S.C. § 103(c), a reference which is prior art under 35 U.S.C. § 102(c) cannot be used in an obviousness rejection under 35 U.S.C. § 103(a), if that reference was owned by the same person or subject to an obligation of assignment to the same person. The pertinent section of 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Both Allen-Rouman and the present application were either owned or under an obligation of assignment to First Data Corporation. Examiner may reference Reel/Frame Number 012940/0859 to view the assignment recordation of Allen-Rouman. Likewise, Examiner can refer to Reel/Frame Number 012842/0993 to view the assignment recordation of the present application. Therefore, 35 U.S.C. § 103(c) precludes the use of Allen-Rouman as a reference in an obviousness rejection.

Without Allen-Rouman, the Examiner has failed to show that all of the elements of independent claims are present in the cited art. Therefore, the Examiner has failed to prove a *prima facie* case for obviousness. The claims are allowable over the cited art.

Requirement for Information Under 37 CFR § 1.105

This efficacy of this requirement has been petitioned to the Director. As such, Applicants will not respond further to this requirement until formal disposition of the petition. Applicants would like the Examiner to know that the Director has found against this type of requirement in other cases. It is believed that the Director will also find favorably for the Applicants in this petition.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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